

REMARKS

Claims 3-5, 9-11, 15-17, 19, 21 and 23-29 are all the claims pending in the present application.

Reconsideration of the application identified in caption in light of the following remarks is respectfully requested.

I. Response to Rejection under 35 U.S.C. § 103(a)

Claims 3-5, 9-11, 15-17, 19, 21 and 23-29 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,045,322 to Blank et al. in view of U.S. Patent No. 6,229,046 to Eyal et al. Applicants respectfully traverse the rejection for the following reasons.

Independent claims 4, 9, 15, 24 and 27 recite, *inter alia*, cyclic lactide, which is a cyclic dimer of an α -hydroxy acid.

Blank et al. relates to antimicrobial superabsorbent compositions of a polymer gel having covalently bonded thereto a silane. Blank et al. describes that the silane component, e.g., 3-(trimethoxysilyl)propyldimethyloctadecylammonium chloride (TMS), acts as an antimicrobial agent and it is essential to incorporate this component in a covalent bonding relationship (col. 4, lines 51-54), so as to obtain polymers that possess in addition to their superabsorbancy characteristics, the property of antimicrobial activity (col. 2, lines 32-34), as opposed to both functioning independently one from the other (col. 2, lines 51-55).

The Office Action fails to establish that other antimicrobial agents taught in the art would provide predictable results in covalently binding the polymer of Blank et al. and providing the desired properties. In this respect, the Board and the CCPA have held that a combination of primary and secondary references is improper in a case in which modification

of primary reference's structure in proposed manner would destroy the invention disclosed in the primary reference for its intended purpose. See, e.g., *Ex parte Sternau*, 155 USPQ 733, 735 (Bd. App. 1967); *Ex parte Westphalen*, 159 USPQ 507 (Ed Pat Appeals Int, 1968); *Ex parte Eastwood, Brindle, and Kolb*, 163 USPQ 316 (Bd Pat Appeals Int, 1968); *In re Meunier*, 434 F2d 657, 168 USPQ 43 (CCPA 1970); *Ex parte Hartmann*, 168 USPQ 43 (Bd Pat Appeals Int, 1974); *Ex parte Thompson*, 184 USPQ 558 (Bd Pat Appeals Int, 1974); and *Ex parte Acosta*, 211 USPQ 636, 637 (Bd Pat Appeals Int, 1979).

Furthermore, in accordance with the teachings of Blank et al., the presence of the silane component covalently bound to the polymer provides effective and sufficient antimicrobial activity. Hence, there would have been no incentive or motivation for a skilled person to include an antimicrobial agent in addition to the silane component in the composition of Blank et al. Moreover, it is clear that Blank et al. intends to avoid the addition of an independently functioning antimicrobial agent.

Eyal et al. relates to techniques for processing lactic acid. Eyal et al. defines the term "lactide" as "a cyclic ester comprising of two lactic acid molecules. That is, it is a dimer of lactic acid" (col. 5, lines 1-2). This definition is consistent with the present application. Eyal et al. further describes that lactic acid oligomers are useful in making lactide, i.e., by chemical conversion (col. 5, lines 44-58). Moreover, Eyal et al. states that the term "lactic acid products" is meant to include, amongst others, lactic acid, lactide, lactic acid trimers and tetramers and lactic acid oligomers (col. 4, lines 57-60).

Based on the description of Eyal et al., one of ordinary skill in the art would understand that the term "lactic acid oligomer," as used in Eyal et al., does not include "lactide." As such, to the extent that Eyal et al. describes that lactic acid oligomers are useful

as antimicrobial agents and as controlled release acidulants for food and agricultural use (col. 5, lines 58-61), it fails to teach the use of lactide as an antimicrobial agent.

As such, even if Blank et al. and Eyal et al. are combined, the combination still would not result in a superabsorbent material containing lactide or a cyclic lactide, as recited in the present claims.

In view of the foregoing, Applicants respectfully that claims 4, 9, 15, 24 and 27 are patentable over Blank et al. in view of Eyal et al., and thus the rejection should be withdrawn. Additionally, claims 3, 5, 10, 11, 16, 17, 19, 21, 23, 25, 26, 28 and 29 depend from claim 4, 9, 15, 24 or 27, directly or indirectly, and thus are patentable over the cited reference at least by virtue of their dependency.

II. Conclusion

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at her earliest convenience.

Respectfully submitted,

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